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In the

Supreme Court of the United States

October Term, 1962

BATESVILLE CASKET COMPANY, INC.,
Petitioner,

vs.

JACWIL MFRS.,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

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INDEX

	Page
Citations	II.
Opinions Below	1
Jurisdiction	2
Question Presented	2
Statement of the Case	3
Argument	5
Appendix	1a
Majority Opinion of the Court of Appeals	1a
Judgment of the Court of Appeals	13a
Judgment and Decree of the District Court	1b
Findings of Fact and Conclusions of Law of the District Court	3b

CITATIONS

Cases	Page
A. G. Spalding & Bros. v. John Wanamaker, 256 F. 530, (p. 533)	8
Eibel Process Company v. Minnesota & Ontario Paper Company, 261 U.S. 45, 63	6
Graver Tank & Mfg. Co. v. Linde Air Products, 339 U.S. 605 (1950)	2, 3, 5, 6, 7, 8, 9
Keystone Co. v. Northwest Engineering Corp., 294 U.S. 42 (p. 48)	8

Statutes

28 U.S.C., Sec. 1254 (1)	2

Federal Rules of Civil Procedure

52a	2, 9

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

Petitioner prays that a writ of certiorari issue to review the judgments of the United States Court of Appeals for the Seventh Circuit entered in the above entitled case on December 21, 1962.

OPINIONS BELOW.

The opinion of the United States Court of Appeals for the Seventh Circuit is now reported in 136 U.S.P.Q. 42, but is not otherwise reported at this time. The opinion and judgment are printed herewith as App. A, page 1a and App. A, page 13a.

The District Court rendered no opinion. Its findings of fact and conclusions of law and judgment are printed

herewith as App. B, page 3b; App. B, page 12b and App. B, page 1b.

JURISDICTION.

The judgment of the United States Court of Appeals for the Seventh Circuit was made and entered on December 21, 1962 (Appeal 13741: App. A, page 13a).

The jurisdiction of this court is invoked under 28 U.S.C., Section 1254 (1).

QUESTIONS PRESENTED FOR REVIEW.

1) In a patent infringement suit, in which a district court makes a finding of fact that each element of the patent claims is embodied in the accused structure and that the accused structure is equivalent to the patented structure, may a court of appeals decline to accord this finding the probity specified by Rule 52(a) of the Federal Rules of Civil Procedure, as specifically applied by this court to such findings of equivalency in the case of *Graver Tank & Mfg. Co.* v. *Linde Air Products*, 339 U.S. 605 (1950)?

2) As a matter of procedural law, may a court of appeals bypass the issue delineated in the preceding question by resort to inferences of claim limitation which the court of appeals surmises from ad hoc statements of the patentee in a subsequent improvement patent, or, remarks of the patent solicitor in the file history of the patent, which do not constitute disclaimer of the equivalency which the district court found?

3) As a matter of procedural law, is it the prerogative of the district court or the court of appeals to construe a patent and delineate the scope of the invention in relation to the equivalency of an accused structure?

4) Does not *Graver* v. *Linde* (*supra*) provide the rule which answers the preceding question?

5) As a matter of substantive law, does the word "estoppel" when used in the expression "file wrapper estoppel" have a meaning which is broader than, and different in significance from, the usual legal meaning, which broader meaning embraces inferences of intent which may be permissive in construing the patent, but do not amount to estoppel, constructively or otherwise, as the term is applied by the courts in all other areas of the law?

6) If the opinion of the Seventh Circuit Court of Appeals in this case be construed as a holding of estoppel, is the decision in direct conflict with the law of the Second Circuit and earlier decisions of this Court?

STATEMENT OF THE CASE.

This appeal arises from an action brought in the District Court for the Southern District of Indiana by Jacwil Mfrs., respondent, a partnership composed of Jack L. White and Wilma Roy White, his wife, of Knightstown, Indiana, against the Batesville Casket Company, Inc., petitioner, an Indiana corporation having its principle place of business in Batesville, Indiana. The action sought a declaratory judgment that Patent No. 2,664,615, owned by petitioner, was invalid, and that respondent had not infringed the patent. Petitioner counterclaimed and charged that respondent had infringed and was infringing its Patent No. 2,664,615 by inducing and contributing to the infringement of the patent by respondent's customers.

The action was tried before the district court at Indianapolis, Indiana on November 1, 2, 3 and 6, 1961. On November 16, 1961, the district court entered a judgment which held respondent had induced and contributed to

the infringement of petitioner's Patent No. 2,664,615, that the patent was valid and represented a significant improvement over the prior art. Respondent appealed to the Seventh Circuit Court of Appeals which reversed the decree of the district court as to the holding that respondent infringed petitioner's patent.

The primary issue of the case, both in the district court and on appeal, was the application of the doctrine of equivalents to the evidence in the case. The district court made an explicit finding of fact 14 that the invention "represent(s) a substantial departure from the prior art" (App. B, 9b) and then made detailed findings of fact 17 and 18, (App. B, 10b and 11b), that respondent's structure embodied the equivalent of each and every element of the claims in suit. That these findings were supported by evidence, which was both competent and substantial, is itself a crucial fact of the case which has not been disputed.

The opinion of the Seventh Circuit Court of Appeals does not directly set aside findings of fact 17 and 18 as manifestly erroneous, but nullifies them, in the language of the opinion, by "a compression of the scope of the claims to a narrower range", (App. A, p. 10a) based on a "documentary examination . . . to further delineate the scope of invention" (App. A, p. 8a) and the court's own inferences as to what "can be surmised" (App. A, p. 10a).

Without explicitly finding disclaimer or file wrapper estoppel as such, the reviewing court compressed the scope of the claims in issue on the basis of arguments presented in the prosecution history and of statements made in the patentee's later issued improvement patent.

In summary, the present posture of the case before this court presents for decision a procedural conflict between a factual determination of equivalency, based on extensive

testimony, by the district court, and an argumentative and essentially legalistic compression of the scope of the invention which the reversing court accomplished by adopting inferences which the district court had rejected.

ARGUMENT

It is respectfully submitted that this petition should be granted because it is addressed to an important issue of procedural law which involves the proper interpretation of Rule 52(a) of the Federal Rules of Civil Procedure. If the reversing decision in this case is sanctioned, then, the procedural law which should apply to this case is not settled, as supposed, by the ruling of this court in *Graver Tank & Mfg. Co.* v. *Linde Air Products*, 339 U.S. 605 (1950). The decision of the court in this case held:

> "A finding of equivalence is a determination of fact. Proof can be made in any form: through testimony of experts or others versed in the technology; by documents, including tests and treatises; and, of course, by the disclosures of the prior art. Like any other issue of fact, final determination requires a balancing of credibility, persuasiveness and weight of evidence. It is to be decided by the trial court and that court's decision, under general principles of appellate review, should not be disturbed unless clearly erroneous." (pp. 609-610)

The outcome of this case, as between the litigants, is not a matter of great public concern, but a consistent interpretation and application of the rules of procedural law is a matter of very great public concern. As matters now stand, the decision to which this petition is addressed is in conflict with the procedural rule in *Graver* v. *Linde* (*supra*) and completely undermines its authority. If the reversing decision is sanctioned, then the rule of *Graver* v.

Linde (*supra*) should be modified or nullified; otherwise, the reversing decision should be set aside. In either case, this petition should be granted.

The reversing decision cites *Graver* v. *Linde* (*supra*) only for the proposition that the claims are the measure of the invention, but ignores the quoted pronouncement of procedural rule.

The district court made findings of fact 6, 14 and 20 (App. B, pp. 5b, 9b and 11b) which held that the invention of the patent in suit stood for a substantial and valuable advance over the prior art, that the invention had gone into commercial use which was successful and advantageous, and that respondent's construction was more like the patent in suit than like the prior art. Hence, the district court gave the patent a relatively broad construction with a substantial range of equivalents, pursuant to the rule of the controlling case, *Eibel Process Company* v. *Minnesota & Ontario Paper Company*, 261 U.S. 45, 63.

The Seventh Circuit Court of Appeals thought that the district court had construed the patent too broadly and, in the language of the opinion, "delineated the scope of the invention" with a resulting "compression of the scope of the claims to a much narrower range." This delineation and compression nullified findings of fact 17 and 18 (App. B, pp. 10b and 11b), which held that each of the claims in suit was limited by the recital of an element which, nevertheless, had as a counterpart a mechanically equivalent element in respondent's construction. These findings were based on substantial and competent evidence.

The reversing decision does not set aside findings of fact 17 and 18 directly as clearly erroneous as findings of mechanical equivalency, but alternatively narrows the interpretation of the patent sufficiently to disqualify and reverse the findings.

The decision of every patent infringement suit which involves the issue of infringement and equivalency inherently requires a balancing of the scope of the patent against the deviations of the attempted evasion. Thus, the delineation of the scope of the invention is implicit in factual findings of equivalency such as 17 and 18, or the findings of equivalency which were before this court in *Graver* v. *Linde* (*supra*). The two dissenting opinions in that case were based on a narrower construction of a patent than that of the district court, which the decision of this court sustained as peculiarly within the province of the district court. Further, the reversing opinion in this case follows the line of patent interpretation and legal reasoning of these dissenting opinions.

The avenue of reversal which the decision below in the present case has followed was equally open to the reviewing courts in *Graver* v. *Linde* (*supra*) and will always be open in all cases in which the infringement issue depends on equivalency. In all cases the claims are infringed or not infringed depending on whether the patent be given a broad or narrow interpretation. If a court of appeals may at its option set aside the factual findings of equivalency of the district court, not as clearly erroneous, but by a new delineation of the scope of the patent, the supposed rule of *Graver* v. *Linde* (*supra*) becomes a nullity and the procedural law reverts to its status of many years ago, when reviewing courts adjudicated cases de novo.

If the reversing decision be construed as a finding of estoppel which bars the action, then this petition should be granted because it is in conflict with both the controlling decision of this court and the decisions of the Second Circuit Court of Appeals as to what constitutes estoppel. Further, there is hopeless confusion at present among the other courts of appeal and, hence, no consistent application of the estoppel principle in actions for patent

infringement. The bench and the bar alike require a guidepost which distinguishes estoppel to assert the infringement from evidentiary elements which must be balanced against other evidentiary elements by the district court in construing the patent to find either infringement or no infringement.

In the present case, the reversing decision repeatedly quotes the remarks of the patent solicitor which do not have "the force of estoppel", *Keystone Co. v. Northwest Engineering Corp.*, 294 U.S. 42 (p. 48). The Second Circuit Court of Appeals has consistently followed this rule: At an early date Judge Learned Hand reiterated the position from which the court has not receded:

> "We take this occasion, however, once more to say that in the consideration of a file wrapper we do not look at the arguments of the applicant to the examiner. . . ."
>
> *A. G. Spalding & Bros.* v. *John Wanamaker*, 256 F. 530, (p. 533).

The Seventh Circuit Court of Appeals' decision in this case quoted application claim 17, which was cancelled, in footnote four; but, findings of fact 17 and 18 which were set aside hold that every element of narrower issued claims has a counterpart in the accused structure. In *Graver* v. *Linde* (*supra*) the narrower claims were not denied the breadth to cover the accused product merely because the broader claims were held unpatentable.

An acute reading of the reversing decision indicates that the court failed to find explicit estoppel as a bar to the action, but if this interpretation of the decision is not accepted, then it is manifest that the court resorted to and was gravely influenced by remarks of the patent solicitor and the text of a later issued improvement patent. If these matters were considered in adjudicating an estoppel,

then the law of the Seventh Circuit is in direct conflict with the law of the Second Circuit and the law of this court.

If there is no conflict of decisions, this court should grant this petition because the Seventh Circuit Court of Appeals has failed to apply the controlling decision of this court, *Graver* v. *Linde* (*supra*), to the findings of fact of the district judge. If there be a conflict of decisions, this court should grant this petition in order to resolve the conflict and eliminate the existing uncertainty as to just how loosely the term, file wrapper estoppel, may be used.

Petitioner maintains that the correct rule of law is, and should be, that the factual findings of equivalency and infringement of the district court are protected by Rule 52 (a) as applied in *Graver* v. *Linde* (*supra*), and may not be set aside by a new delineation of the scope of the invention, but may be nullified or rendered moot by a definite, discrete estoppel which bars the action.

Respectfully submitted,

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APPENDIX A

In the

United States Court of Appeals

For the Seventh Circuit

No. 13741 SEPTEMBER TERM, 1962 SEPTEMBER SESSION, 1962

JACWIL MFRS.,
Plaintiff-Appellant,

v.

BATESVILLE CASKET COMPANY, INC.,
Defendant-Appellee.

Appeal from the United States District Court for the Southern District of Indiana.

December 21, 1962

Before DUFFY, CASTLE and SWYGERT, *Circuit Judges.*

SWYGERT, *Circuit Judge.* This appeal arises from a declaratory judgment action instituted by plaintiff, Jacwil Mfrs., to have Letters Patent No. 2,664,615 (hereinafter referred to as the '615' patent) declared not infringed or, if infringed, invalid. Defendant, Batesville Casket Company Inc., assignee of the '615' patent, counterclaimed for patent infringement.[1] After a trial without jury the District Court entered judgment for defendant. Plaintiff was

[1] Throughout this opinion reference will be made to two Hillenbrand patents. Mr. Hillenbrand, Secretary of the Batesville Casket Company and also its Production Manager, was copatentee and assignor to Batesville of Letters Patent 2,664,615 (the patent in suit), issued on January 5, 1954. In addition, he was the patentee and assignor to Batesville of Letters Patent 2,964,824, issued on December 20, 1960. Both patents deal with casket interior units and herein are referred to as the '615' patent and the '824' patent respectively.

enjoined from infringing or contributing to the infringement of the patent.

Plaintiff seeks a reversal on the ground that the file wrapper history of the patent narrowly confines the scope of the patent claims and hence the District Court erred in applying the doctrine of equivalents so as to encompass the accused structure.

The subject matter of the patent in suit relates generally to the interior trim or decoration of burial caskets, and particularly to molded cardboard inserts for lining the interior of metal casket lids. These inserts greatly reduce the time required to line a casket lid and permit unskilled labor to be used with a concomitant savings in labor costs. The Batesville insert, covered by the '615' patent, comprises a rectangular frame of rigid side and end frame members rigidly fastened at their abutting ends. A center panel is stapled to the inner marginal portions of the frame members. The frame members are constructed of single face corrugated cardboard curved over forms or "webs" to provide a convex face which simulates an upholstered roll. A marginal flange member is formed along the inner edges of the frame members for stapling the same to the center panel. The webs are constructed of several laminations of corrugated board secured together by adhesive. The corrugated board is cut along a curved profile approximating the desired curvature of the frame members. As such the webs constitute a rigid truss section. The webs are secured along their profiled surface to the corrugations of the single face by adhesive. Thus, the corrugated board is maintained in a curved configuration conforming to the profile of the webs.

The ends of the frame members are configurated so as to constitute mitred corners when in the abutting relationship. At the ends of each of the frame members are a plurality

of tabs or flanges (hereafter referred to as tabs) which are bent inwardly at substantially right angles thereto. The tabs on abutting frame members are stapled together in a face-to-face relationship whereby the frame members constitute a rigid frame assembly. A suitable lining of silk or the like is stretched over the frame members and is secured thereto by stapling and/or adhesive. The silk lining is stretched over the ends of each frame member and the tabs thereon. Thus, when two frame members are joined in right angular fashion, the lining folded over the ends is stapled between the tabs. The appearance resulting is that of an upholstered mitred corner.

Plaintiff's accused insert is indistinguishable from defendant's when viewed in its final upholstered condition in a casket lid. Inspection of the two constructions, however, shows that the webs are absent from the frame members of the accused device and there are no tabs at the abutting corners as described in the '615' patent. In place of webs, the accused device employs corrugated board formed in a curve at right angles to the corrugation grooves with a chipboard glued face-to-face to the corrugated board in this configuration. When the corrugation grooves are on the convex side, the corrugations are forced into a much wider spatial relationship than if uncurved. When the chipboard is glued to the corrugations it fixes the corrugations in the spatial relationship they had previously assumed. After the glue has hardened the curved form is set and will not return to its former uncurved condition.

As for the mitred corners there appears to be much disagreement between the parties as to the difference between a mitred joint and a cope joint (the latter being claimed as descriptive of the corner joint of the accused device). Merriam-Webster's New International Dictionary (unabridged) Third Edition (1961), lists the word "cope" as a verb

transitive and not as a noun. We view both joints as being miter joints in their final appearance. We do not believe it is the appearance here that is patentable but rather the means or method used in arriving at the mitred appearance.

The accused device does not include inwardly turned flanges or tabs at the ends of the frame members. The longitudinal members are merely cut or shaped to conform to the shape of the transverse member. The overlapping of the longitudinal frame member on the transverse member may occur over a substantial portion of the transverse member's length and results in a line of overlap that is at a 45° angle to both the longitudinal and transverse members. The longitudinal and transverse members are not permanently fixed in relation to one another until they have been matched with a casket lid. The fact that the longitudinal member can overlap the transverse member over a substantial range of the transverse member's length permits the accused insert to be tailored to fit varying lid dimensions and still maintain a mitered corner. This flexibility is not present when tabs as described in the '615' patent are used.

We are thus faced with a situation in which the two inserts in their ultimate upholstered appearance are, or may be, identical. As already noted it is not the appearance but rather the structure utilized in arriving at the appearance that constitutes the patented invention. The claims of the '615' patent are the measure of invention. *Graver Tank & Mfg. Co. v. Linde Air Products*, 339 U. S. 605 (1950). The District Court recognized the limitations present in the claims of the patent regarding the profiled webs used to reinforce the frame members of the insert and also the tabs or flange used at the corners to form the mitered appearance. This recognition is contained in the

District Court's findings of fact 17 and 18[2] in which the trial judge applied the doctrine of equivalents in determining that the accused device contained all the essential elements of the '615' patent.

The significance and validity of this determination of equivalency depends on findings of fact 19 and 20.[3]

For reasons to be discussed, we hold that the scope of the claims of the two Hillenbrand patents is limited by their prosecution history and hence finding of fact 19 is clearly erroneous. Thus limited the patent claims cannot be expanded by the doctrine of equivalents so as to embrace those particulars excluded by the prosecutional history of

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[2] Finding of fact 17 reads:

"In claims 6 and 7 of defendant's patent, the frame members are described as constituted by paperboard material configurated to display a curved face, and a plurality of webs secured to the inner face of each of the frame members to maintain the curvature. The patent drawings show three to five such webs secured to the inner face of the members. Plaintiff does not employ the particular webs shown in the patent drawings. Rather, the plaintiff secures an elongated strip of corrugated paperboard to the inner face of the members to maintain the curvature. The plaintiff's longitudinal strip of corrugated paperboard may be considered to be a plurality of individual transverse strips (or webs) of corrugated paperboard integrally joined into a single elongated strip. The longitudinal strip employed by the plaintiff is found to be substantially the same means as the claimed plurality of webs in that it accomplishes the same result in substantially the same way as the plurality of webs."

Finding of fact 18 reads:

". . . The structure employed by plaintiff is the mechanical equivalent of the flanges secured together as claimed by the defendant in claims 9 to 13 in that the plaintiff's structure is adapted to perform the same result (a neat mitred corner) by substantially the same means functioning in substantially the same way (the abutting and overlapping frame members stapled at their corners and around the tacking frame in the peripheral edges of the casket top or inserted in the channel)."

[3] Finding of fact 19 reads:

"The prosecution history of the two Hillenbrand Patents in no way limits the scope of the patent claims in issue and particularly the scope of such claims set forth in these Findings as covering and embracing the casket interior units or components thereof which plaintiff has made, used and sold presently and in the past and such units assembled from such components supplied by plaintiff and sold by plaintiff's customers presently and in the past."

Finding of fact 20 reads:

"Plaintiff's structure in its component parts and the assembled unit does not follow the prior art, but follows defendant's patent."

the patent. *Lewis v. Avco Manufacturing Corp.*, 228 F. 2d 919 (7th Cir. 1956). Of necessity, finding of fact 20, flowing from an erroneous application of the doctrine of equivalents, must also fail as being clearly erroneous.

When each of the claims in suit are studied, it is apparent that each calls for a rectangular frame having mitred corners and attached to a central panel. In addition, each claim calls for the supporting profiled webs and/or the tabs at each mitred corner.

On each occasion when the inventor attempted to submit a claim which did not include either the tabs or the webs the claim was rejected by the Patent Examiner. Several letters exchanged between the Examiner and the inventor in response to submitted claims reveal the inventive-level characteristics of the structure for which the patent in suit ultimately issued. On June 14, 1951, the Examiner wrote:

> "In view of the fact that it is old in the casket art to make removable casket top interior units, applicant is requested to condense the first six pages of the specification of this application to not more than two pages.
>
> * * * *
>
> "Claims 4, 7 and 11 are rejected as unpatentable over Bowler (1) which discloses an interior unit 26 for a casket top comprising a rectangular frame constituted by four frame members formed of cardboard and each configurated at the ends to provide mitred joints, . . . casket lining fabric 16 facing each frame member, and a central panel supported by said frame. To construct the Bowler unit 26 of 'corrugated' paper board would involve only a matter of choice not amounting to invention, nor would it require any invention to dispose the corrugations lengthwise of the frame members. It would be obvious to one skilled in the art that the corrugations should be disposed lengthwise of the members since the cardboard is easier to bend with the corrugations disposed in this manner."

On December 12, 1951, Hillenbrand submitted proposed amendments to his patent in answer to the Examiner's letter of June 14. Each of the new claims included reference to the webs or tabs except for claim 17.[4] In the remarks at the end of the letter the writer pointed out that "[t]he claims of the new set are directed to the details of construction of the unit which give it its rigidity and make the frame and the central panel individually, self-sustaining sub-assemblies." The remarks continued:

> "In addition to the self-sustaining feature, it is to be noted that each of the new claims describes the frame members as being configurated 'to display a curved face outwardly.' This configuration is neither shown nor suggested in the Bowler disclosure and not only adds considerably to the inherent strength of the frame members but, in addition, simulates the appearance effected by genuine upholstery techniques."
>
> ". . . Claim 17 is directed specifically to the self-sustaining nature for the construction of the frame . . . . *Claim 18 adds to the recitation of Claim 17, the webs which are used to strengthen the frame member.*" (Emphasis supplied.)

Claim 17 is the only new claim in which tabs or webs were not mentioned. In response to these proposed amendments the Examiner, on August 14, 1952 wrote:

> "Claim 17 is rejected as defining nothing patentable over each of the Bowler patents of record. To make the side and end members of the frame shown in Figs. 1, 2 and 8 of Bowler (1) and in Figs. 15, 16 of Bowler

[4] Claim 17 read:

"An interior unit for a casket top comprising a self-sustaining rectangular frame having side and end members constituted by paper board material configurated to display a curved face outwardly and a self-sustaining panel of shallow dish-like configuration secured marginally to the inner edge of the frame to constitute a rigid assembly adapted to be inserted as a unit in the top of the casket."

(2) curved outwardly and to make the center panel of these units of shallow dish-like configuration would involve only mechanical skill not amounting to invention. The configurations of these portions of the units appears to be purely a design feature, the recitation of which is not sufficient to patentably distinguish over the prior art."

Claim 18 was allowed in the same letter. As noted, this differed from Claim 17 only in the addition of the webs which are used to strengthen the frame members.

On October 27, 1952, the inventor again submitted proposed amendments. This letter contained the following remarks:

". . . The result is a rigid, self-sustaining frame having casket lining material in the mitred crevices. The combination of the curvature, the mitred joints, inwardly turned flanges and mitred crevices is suggested nowhere in the prior art.

"The advantage of having a self-sustaining frame in a casket interior unit of the type described can be seen from the photographs. For one thing, the central panel does not have to be a structurally strong element. It undoubtedly adds to the overall rigidity of the unit, but it is believed to be apparent that cloth or other limp material could be utilized in place of paperboard, for example."

One more documentary examination serves to further delineate the scope of invention of the patent in suit. In 1957, Hillenbrand filed an application for a patent covering improvements in casket interior units. This application subsequently resulted in the issuance of Letters Patent Number 2,964,824 (referred to as the '824' patent). Some of the language contained in this latter patent helps to explain what it was that the inventor deemed of substan-

tive importance in his first patent. The '824' patent reads in part as follows:

> "This patent discloses a prefabricated interior unit constituted by corrugated paperboard, pasteboard or light sheet materials covered by an upholstering fabric which is adapted to provide a pleasing appearance. In general, these inserts, or interior units, have comprised a rectangular central panel surrounded by a frame constituted by four frame members, one on each side. Also, in general, it has been customary to bow the frame members inwardly to simulate upholstering and *to maintain the bow of the sheet material of the frame members by means of stays attached to the insert on the side opposite to the exposed side.*
>
> * * * * *
>
> "The improved prefabricated insert or interior unit of this invention is an improvement over the interior unit of Patent No. 2,664,615 in that it can be much more rapidly fabricated with less material and with the requirement for less skill than the interior unit of the patent. *Particularly,* the unit of this invention *does not require the stays* for bowing the frame members of the patent and further . . ."
>
> * * * * *
>
> "The construction of the interior unit of this invention is superior to the construction of the interior unit of Patent No. 2,664,615 regardless of the manner by which the interior unit is attached to the inside of the casket top *because the construction dispenses with the use of stays for stabilizing the frame members.* In other words, in the preferred construction of Patent No. 2,664,615, the frame members are relatively rigid and self-sustaining, whereas the frame members of this invention are relatively flexible and are held in the desired configuration only after the interior unit is placed in the casket top whereby the flanged joints stabilize the positions of the inner margins of the frame members and the attachment to the casket top stabilizes

the positions of the outer margins of the frame members." (Emphasis supplied.)

From this it can be surmised that the need for stays or webs in the '615' patent was a nuisance and the patentee recognized that these stays were a vital part of his original patent. This frame of mind seems justifiable from the quotations we have recited above and we believe that the entire file wrapper history of the '615' patent, and the '824' patent as above noted calls for a compression of the scope of the claims to a much narrower range than that allowed by the District Court.

The file wrapper history shows that a self-sustaining frame with stays or webs giving strength as well as form to the frame members, and with mitred corners made possible by stapled tabs or flanges at the abutting ends—also adding to the strength of the whole—constitute the essence of the '615' invention. This was not a pioneer invention in the field of casket inserts, but rather was an improvement on the prior art, and the correspondence with the Examiner sustains this view. Looking through the correspondence to the patents cited by the Examiner convinces us that the Examiner's position would have been sustained had the applicant chosen to contest his decisions. Particularly is this so with regard to Bowler Patent Number 2,181,504, and Bowler Patent Number 2,044,967.

The District Court applied the doctrine of equivalents in its findings of fact 17 and 18. In so doing it found the chipboard glued to the corrugated board to be an equivalent of the stays or webs mentioned in the '615' patent. In view of our discussion we must disagree. To grant the equivalence in this instance would be to give to the '615' patent a scope broad enough to encompass that which the Patent Office refused to allow. The stays, being rigid and perpendicular to the plane of corrugated board, added

strength to the frame and a rigidity that was called for in the claims. The accused device uses a chipboard that permits flexibility—an attribute that is one of the very desirable features of its design. In this context we cannot hold it to be an equivalent when an exact duplication of the patented item, with its basic characteristic of rigidity, would destroy that particular feature which is most novel in the component utilized by the accused device. The same may be said about the tabs or flanges used at the corners. These are mentioned again and again in the claims as the means by which a mitred corner may be achieved, and they add considerably to the self-sustaining rigidity of the patented insert. Again, to classify as an equivalent a feature that is designed to permit flexibility in the accused insert and which lacks any of the attributes called for by the patented insert, save for final appearance which we have already said was not patented, would grant to the patentee a monopoly over casket lid inserts not anticipated by the Patent Office and would seriously call into question the validity of the patent in light of the file wrapper history already discussed.

We realize that each case must stand on its own facts. Particularly is this true where file wrapper estoppel is raised as a defense to an infringement action. The line between what is patentable and what has been properly disallowed must be recognized when applying the doctrine of equivalents. In this regard it is well to recall what was said by Judge Major in *Lewis* v. *Avco Mfg. Corp.*, 228 F. 2d 919, 925 (7th Cir. 1956):

> "If the difference between tweedledum and tweedledee represented the margin between the prior art and the patent as allowed, the patentee would not be heard to assert that such difference was of no consequence on the issue of infringement."

For the foregoing reasons the trial judge erred in holding that plaintiff infringed defendant's patent. Accordingly, the judgment of the District Court is reversed.

A true Copy:

Teste:

.....

Clerk of the United States Court of Appeals for the Seventh Circuit.

UNITED STATES COURT OF APPEALS
For the Seventh Circuit
Chicago 10, Illinois

Friday, December 21, 1962

Before:
Hon. F. Ryan Duffy, C. J.
Hon. Latham Castle, C. J.
Hon. Luther M. Swygert, C. J.

JACWIL MFRS.,
Plaintiff-Appellant,
No. 13741 vs.
BATESVILLE CASKET COMPANY,
Defendant-Appellee.

Appeal from the United States District Court for the Southern District of Indiana, Indianapolis Division.

This cause came on to be heard on the transcript of the record from the United States District Court for the Southern District of Indiana, Indianapolis Division, and was argued by counsel.

On consideration whereof, it is ordered and adjudged by this Court that the judgment of the said District Court in this cause appealed from be, and the same is hereby, REVERSED, with costs, in accordance with the opinion of this Court filed this day.

APPENDIX B

UNITED STATES DISTRICT COURT
Southern District of Indiana
Indianapolis Division

No. IP 60-C-175

JACWIL MFRS.,
Plaintiff,

v.

BATESVILLE CASKET COMPANY, INC.,
Defendant.

JUDGMENT AND DECREE

Upon the Findings of Fact and Conclusions of Law heretofore entered, the Court now enters the following Judgment and Decree.

Judgment is entered for the defendant and against the plaintiff on plaintiff's complaint.

Judgment is entered for the countercomplainant and against the counterdefendant on the amended and supplemental countercomplaint and replies thereto.

The Court adjudges that Batesville Casket Company, Inc.'s Patent Number 2,664,615 is valid, and that John L. White and Wilma Roy White, partners doing business under the firm name of Jacwil Manufacturers, have contributed to the infringement of claims 6, 7, 9, 10, 11, 12 and 13 of such patent, and have infringed claims 6, 7, 9,

10, 11, 12 and 13 of such patent by inducing others to so infringe.

Pursuant to the Pretrial Order, the Court retains jurisdiction of this cause for the purpose of hearing evidence on the issue of countercomplainant's damages, attorney fees and costs.

The counterdefendant is enjoined until the 5th day of January, 1971, from manufacturing, selling or inducing others to manufacture or sell the panel *molded inserts* described in plaintiff's complaint, or in *any other way* infringing or contributing to the infringement of countercomplainant's Patent Number 2,664,615. The Court retains jurisdiction of this cause to enforce this Decree.

Defendant and countercomplainant is entitled to recover its costs to this date against the plaintiff and counterdefendant which are assessed in the sum of $.....

Dated this 16 day of November, 1961.

CALE J. HOLDER
Cale J. Holder, Judge, United States District Court Southern District of Indiana

(CAPTION OMITTED)

FINDINGS OF FACT AND CONCLUSIONS OF LAW

The trial of this action commenced the afternoon of November 1, 1961 and continued through November 2, 3, and concluded on November 6, 1961. The liability issues tried were made-up by the plaintiff's complaint for declaratory judgment that defendant's patent is invalid and/or is not infringed by plaintiff which was filed July 7, 1960; defendant's answer to the complaint filed July 14, 1960, defendant's counterclaim for plaintiff's alleged infringement of defendant's patent, damages and injunction filed July 14, 1960 and as amended January 16, 1961 and July 3, 1961; plaintiff's reply to the counterclaim filed August 8, 1961 and as amended on June 1, 1961; defendant's supplemental counterclaim filed October 25, 1961; and plaintiff's reply to the supplemental counterclaim filed November 1, 1961. Pursuant to Rule Number 42(b) of the Federal Rules of Civil Procedure, the Court in pretrial conference approved the parties stipulation and ordered the separation of the issues of liability and damages with the submission of the liability issues to be determined first. The Court having considered the evidence, testimony of witnesses, including oral testimony of experts, depositions, interrogatories and answers thereto, patent exhibits, charts, documentary and physical exhibits, stipulations of the parties and admissions in the pleadings; and being duly advised in the matter, the Court submits its

FINDINGS OF FACT

1. The plaintiff, Jacwil Manufacturers, is a partnership composed of John L. White and Wilma Roy White with its principal place of business in Knightstown, Indiana.

The defendant, Batesville Casket Company, Inc., is a corporation organized and existing under and by virtue of the laws of the State of Indiana having its regular and established place of business at Batesville, Ripley County, Indiana.

2. The defendant has manufactured caskets continuously for more than fifty (50) years and at the time of trial was one of five largest producers and sellers of caskets in the United States of America.

3. Until about 1950, the casket industry furnished the interior of substantially all caskets by decorative upholstery which resulting appearance was an essential element of the industry's finished product. Upholstery was accomplished similar to the furniture industry. It was a source of delay and expense to the casket industry in that it required skilled artisans, training time of such artisans, high wages, lack of uniformity of product, limitations as to quantity, and costly raw materials.

4. C. C. Hillenbrand for many years prior to 1950 was in charge of production of the defendant and since the early 1930's experimented in his quest for a decorative casket lid insert or lining as a substitute for the upholstery. Mr. Hillenbrand and Millard J. Laugle on July 24, 1950 filed their application, Serial Number 175,599, for a patent relating to casket top or lid interior units for both full couch and half-couch caskets having a dome type of top or lid with the object of mass production and installation by unskilled labor with inexpensive materials. The United States Patent Office issued a Patent Number 2,664,615 to

the defendant as assignee of such applicants on January 5, 1954 consisting of thirteen (13) claims. The defendant is the owner of such patent. A copy of such patent is attached hereto, is marked Exhibit "A", and made a part of this Finding. The defendant timely noticed plaintiff that the claims of its patent infringed by plaintiff's structures are claims 6, 7, 9, 10, 11, 12, and 13.

5. The claims in issue of the patent provide for an integral unit, premolded and assembled interior of a casket lid simulating the furniture type upholstery, but made of paperboard with a fabric covering for inserting in a burial casket lid.

6. In 1950, and for six (6) years, the defendant successfully offered the invention into commercial practice with success. The result of such product was the equal or greater attractiveness to the furniture type upholstered casket, uniformity in appearance, greater economies in raw materials and wages, mass production in greater quantity in less time, installation time was greatly minimized, and the use of comparatively unskilled labor for manufacture and installation.

7. The plaintiff does not manufacture caskets but does manufacture and supply casket manufacturers with equipment, machinery and supplies. Mr. White had from time to time, prior to 1959, received requests or inquiries concerning premolded casket lid inserts. In March or April of 1955, Mr. White sold and delivered automatic form equipment to defendant's plant. Mr. Hillenbrand conducted Mr. White on a tour of defendant's plant where he observed defendant's commercial product of its patent.

8. Mr. White has innovated various products for plaintiff's business. Mr. White has some acquaintance with patents and the effects thereof in that he applied for and secured a patent, the subject of which is in no way related

to the issues of this case. In December of 1959, Mr. White turned his attention to the perfecting of a premolded casket lid insert for the manufacture and sale thereof to the various manufacturers of caskets. In the matter of a very short time, he perfected such mission which he disclosed at a trade convention. Mr. White then called upon defendant who informed him that his structure infringed its patent. Mr. White then employed counsel who advised that his structure did not infringe and Mr. White proceeded to manufacture and sell the unassembled parts of his structure to casket manufactures including National Casket Company one of the five largest manufacturers of caskets in the United States of America. Such parts are not staple articles of commerce for non-infringing use. After some negotiations with defendant and before the expiration of the negotiation time agreed upon and requested by Mr. White of defendant, the plaintiff instituted this action for venue purposes as well as those issues stated in the complaint.

9. Plaintiff has continued to the date of trial in the manufacture and sale of his structure with success. Mr. White conducted schools to instruct the employees of plaintiff's customers in the use of his structures. Plaintiff advertised the structure in the trade magazine of the casket industry. Plaintiff has induced others to use his manufactured parts in the fabricating of casket lid inserts. Plaintiff's customers have assembled such components into units inserted them in caskets and sold such caskets with success.

10. The plaintiff asserts that the defendant's patent is invalid by reason of prior art and showing the state of the art in the following patents:

Bowler Patents Number 2,044,967 and 2,181,504 were both referenced by the United States Patent Office in defendant's patent. These patents provide for removable interiors of casket lids by means of releasable fasteners.

The patents do not provide for the simulation of furniture type upholstery by the use of a paperboard unit with a fabric covering for inserting in a casket lid.

Overstreet Patent Number 1,931,828 was referenced by the United States Patent Office in defendant's patent. This patent provides for a removable center panel and lining of casket lids. The patent does not provide for the simulation of furniture type upholstery by the use of paperboard unit with a fabric covering for inserting in a casket lid.

Harford Patent Number 898,047 was not referenced by the United States Patent Office in defendant's patent. This patent does not refer specifically to the art of the casket industry but refers to the stretching of lace curtain. It provides for an adjustable frame with teeth thereon. The patent does not provide for the simulation of furniture type upholstery by the use of paperboard unit with a fabric covering for inserting in a casket lid.

Freeman Patent Number 1,128,865 was not referenced by the United States Patent Office in defendant's patent. This patent provides for a combined casket and grave vault of waterproof material and construction and for a decorative removable shell casing which may be removed upon interment and which shell may be reused. The patent does not provide for the simulation of furniture type upholstery by the use of paperboard unit with fabric covering for inserting in a casket lid.

Smyser Patent Number 1,943,094 was not referenced by the United States Patent Office in defendant's patent. This patent provides for a burial case which will not deteriorate under ground nor collapse under the weight of earth and sealed from moisture. The patent does not provide for the simulation of furniture type upholstery by the use of paperboard unit with fabric covering for inserting in a casket lid.

Adams Patents Number 2,422,998 and 2,432,849 were not referenced by the United States Patent Office in defendant's patent. These patents do not refer specifically to the art of the casket industry, but one refers to storage, warehouse, and shipping industries requiring platforms, skids, or pallets the other refers to the paper products industry. The earliest patent is a method patent for the making of laminated corrugated paper articles. The later patent provides for laminated corrugated paper platforms, skids or pallets. These patents do not provide for the simulation of furniture type upholstery by the use of paperboard unit with fabric covering for inserting in a casket lid. The defendant's patent is not a method patent, and to utilize the claims thereof would not require the Adams method or process even though preferable.

Jurgensen Patent Number 1,735,684 was not referenced by the United States Patent Office in defendant's patent. This patent does not refer to art of the casket industry, but refers to the pipe insulation industry. It provides for the method of making air-cell pipe covering. The patent does not provide for the simulation of furniture type upholstery by the use of paperboard unit with fabric covering for inserting in a casket lid.

Hillenbrand Patent Number 2,964,824 is a later issued patent than the one in issue and was not offered in evidence as prior art but for a limited purpose.

Agar Patent Number 1,619,011 was not referenced by the United States Patent Office in defendant's patent. The patent does not refer to the art of the casket industry but to packaging and the shipping industry. The patent provides for a shipping form made of corrugated paper. The patent does not provide for the simulation of furniture type upholstery by the use of paperboard unit with fabric covering for inserting in a casket lid.

11. The prior art relied on by plaintiff does not contain anything constituting a complete anticipation of any of the thirteen (13) claims in suit. Every prior art cited by plaintiff lacks one or more of the features required by each of the thirteen (13) claims of defendant's patent.

12. The plaintiff is a licensee under the earlier Adams Patent by reason of a written contract entered into since the commencement of this action.

13. Other than the license of plaintiff, the prior art patents asserted by plaintiff have never been the subject of commercial use and especially in the casket industry.

14. The defendant's thirteen (13) patent claims are new and novel and represent a substantial departure from the prior art relied upon by plaintiff.

15. The plaintiff manufactures and sells pre-shaped and configurated corrugated paperboard members which are adapted to be covered with fabric and stapled together to form a self-sustaining unit consisting of five elements; namely, a center panel and four frame members. The four frame members which are first covered with fabric have flanges on their inner edges which are stapled to the peripheral edges of the center panel, the stapling effecting the sandwiching of the fabric in the crevices formed by the center panel and the flanges. The frame members have outer edgewise portions which are adapted to be stapled or tacked to a rectangular wooden tacking frame secured to the peripheral edge of a casket top or into a channel around the peripheral edge of a casket top without tacking or stapling. When the assembly is tacked or stapled to the rectangular frame or inserted in such channel, the unit is wholly supported by the tacking frame or channel and the adjoining paperboard frame members are in abutting engagement with the fabric on the adjoining frame members meeting at the crevices formed at the abutment to provide mitred corners.

16. In respect to the elements . . their organization, as described above, there is exact identity between plaintiff's accused structure and the language of the defendant's claims 6, 7 and 9 to 13.

17. In claims 6 and 7 of defendant's patent, the frame members are described as constituted by paperboard material configurated to display a curved face, and a plurality of webs secured to the inner face of each of the frame members to maintain the curvature. The patent drawings show three to five such webs secured to the inner face of the members. Plaintiff does not employ the particular webs shown in the patent drawings. Rather, the plaintiff secures an elongated strip of corrugated paperboard to the inner face of the members to maintain the curvature. The plaintiff's longitudinal strip of corrugated paperboard may be considered to be a plurality of individual transverse strips (or webs) of corrugated paperboard integrally joined into a single elongated strip. The longitudinal strip employed by the plaintiff is found to be substantially the same means as the claimed plurality of webs in that it accomplishes the same result in substantially the same way as the plurality of webs.

18. The defendant's claims 9 to 13 call for inwardly turned tabs or flanges on the side edges of the frame members, the tabs or flanges of adjoining frame members being secured together to provide the mitred corners with casket lining fabric in the mitred crevices. The plaintiff teaches stapling the fabric ends to the inner face of the end frame members and gluing the fabric ends to the ends of the inner face of the side frame members. The side frame members have end edge portions abutting the end frame members and portions overlapping the end frame members at the corners. The overlapping portions may be stapled together prior to or during insertion in

the casket. The stapling of the corners and/or the mounting of the unit in the casket top brings the side frame members into snug engagement with the frame members to form mitres with the fabric in the mitred crevices. The structure employed by plaintiff is the mechanical equivalent of the flanges secured together as claimed by the defendant in claims 9 to 13 in that the plaintiff's structure is adapted to perform the same result (a neat mitred corner) by substantially the same means functioning in substantially the same way (the abutting and overlapping frame members stapled at their corners and around the tacking frame in the peripheral edges of the casket top or inserted in the channel.

19. The prosecution history of the two Hillenbrand Patents in no way limits the scope of the patent claims in issue and particularly the scope of such claims set forth in these Findings as covering and embracing the casket interior units or components thereof which plaintiff has made, used and sold presently and in the past and such units assembled from such components supplied by plaintiff and sold by plaintiff's customers presently and in the past.

20. Plaintiff's structure in its component parts and the assembled unit does not follow the prior art, but follows defendant's patent.

21. The plaintiff intends to continue in the future to manufacture and sell and to induce his customers to assemble, install and sell their caskets equipped with the accused structures.

22. The defendant has been damaged in at least the sum of $1.00 by reason of plaintiff's actions and has incurred the further expense of attorney fees and costs.

CONCLUSIONS OF LAW

1. The Court has jurisdiction of the parties and of the subject matter of the action.

2. The plaintiff has not proved by a preponderance of the evidence all of the essential elements and facts of the complaint.

3. The defendant has proved by a preponderance of the evidence all of the essential elements and facts of the amended counterclaim and supplemental counterclaim.

4. The plaintiff has not proved by a preponderance of the evidence all of the essential elements and facts of the affirmative reply to the amended counterclaim and supplemental counterclaim.

5. United States Patent Number 2,664,615 and each of its thirteen (13) claims is and are valid.

6. Plaintiff has infringed such patent by inducing others to infringe such patent and particularly its claims 6, 7, 9, 10, 11, 12 and 13.

7. Plaintiff has contributorily infringed such patent by selling components of a patented combination knowing the same to be especially made or especially adapted for use in an infringment of such patent, particularly claims 6, 7, 9, 10, 11, 12 and 13 and not a staple article of commerce suitable for non-infringing use.

8. The deviations which plaintiff has employed over such patented structures are full mechanical equivalents of the structures claimed in such patent.

9. The defendant is not estopped from asserting the scope of the claims in issue of such patent as to cover or embrace the casket interior units or components thereof made, used or sold presently or in the past, or any casket interior units assembled from components supplied by plaintiff and sold by plaintiff's customers presently or in

the past by reason of any proceedings had or taken in the United States Patent Office in the prosecution of any Application for Letters Patent.

10. The scope of the patent in issue is not affected by reason of any proceeding had or taken in the United States Patent Office in the prosecution of any Application for Letters Patent.

11. Defendant is entitled to an injunction against the plaintiff against infringement direct or contributory of such patent.

12. The Court retains jurisdiction of the case in keeping with the Court's pretrial order (item 10) of January 9, 1961 for trial of the remaining issues of the amended counterclaim and supplemental counterclaim and replies thereto limited to damages, attorney fees, costs and interest.

13. Every Finding of Fact deemed a Conclusion of Law is hereby adopted as a Conclusion of Law.

The Clerk will enter judgment in accordance with these Findings of Facts and Conclusions of Law with Court costs to this date assessed in the sum of $..... against plaintiff and place the case on the trial calendar for the trial of the remaining issues.

Dated this 16 day of November, 1961.

CALE J. HOLDER
Cale J. Holder, Judge, United States District Court Southern District of Indiana

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1962

NO. 806

BATESVILLE CASKET COMPANY, INC.,
Petitioner,

v.

JACWIL MFRS.,
Respondent

BRIEF FOR RESPONDENT IN OPPOSITION

PATRICK H. HUME,
CLYDE F. WILLIAN,
38 South Dearborn Street,
Chicago 3, Illinois

TWENTIETH CENTURY PRESS, INC., CHICAGO 6

IN THE

Supreme Court of the United States.

OCTOBER TERM, 1962

No. 806

BATESVILLE CASKET COMPANY, INC.,
Petitioner,

v.

JACWIL MFRS.,
Respondent

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

BRIEF FOR RESPONDENT IN OPPOSITION

OPINIONS BELOW AND JURISDICTION

Respondent adopts the allegations of the Petition (pp. 1-2) under these headings, but notes that the Opinion of the United States Court of Appeals for the Seventh Circuit (Pet. App. A) is also reported at 311 F.2d 38. The findings of fact and conclusions of law, entered without Opinion by the District Court (Pet. App. B.; R. 287-297)[1], are unreported.

1. "R." refers to the printed record below for use by the Appellate Court that comprises plaintiff-appellant's appendix unless otherwise indicated.

PETITIONER'S QUESTIONS PRESENTED

At the outset, respondent denies that this case presents any question that merits the attention of this Court, as will appear below.

Each of the first four questions presented in the Petition (pp. 2-3) is directed to the Doctrine of Equivalency in determining infringement of patent claims, in an obvious attempt to bring this case under the *Graver Tank & Mfg. Co.* v. *Linde Air Products*, 339 U. S. 605, precedent of this Court. However, the Court below reversed on file wrapper estoppel, the Trial Court's holding of infringement. The rationale of file wrapper estoppel excludes equivalency according to the settled law of this Court, and so excludes the possibility of conflict with the *Graver* case.

Questions 5 and 6 apparently deal with estoppel, but the fifth question is so involved and hypothetical as to be unintelligible as to its applicability to the present case, and of no possible interest beyond petitioner's private concerns. As to the sixth and final question, there are no known conflicts with prior decisions of this Court, the *Graver* case being inapposite for reasons noted, while other decisions of the Court, noted below, expressly approve both the rationale and the action taken by the Seventh Circuit Court of Appeals in this instance.

In petitioner's argument (Pet. p.8) *Spaulding Bros.* v. *John Wanamaker*, 256 F. 530, 533, is cited to show apparent conflict between the Seventh and Second Circuits in this matter of estoppel. There, Judge Learned Hand admonished not to regard an applicant's arguments to the Examiner in evaluating file wrapper estoppel. But the present decision of the Court below did not turn on such representations, rather on the specifications of two of peti-

tioner's patents, the drawings, and the claims presented for consideration, some of which were patented, others of which were canceled. These are the settled standards to evalue file wrapper estoppel laid down by this Court, that are followed by the Second Circuit Court of Appeals, as well as every other Court in the land.

Petitioner's questions are, therefore, without merit.

PETITIONER'S STATEMENT OF THE CASE

Respondent accepts the statement of the case set forth in the first two paragraphs under this heading (Pet. pp. 3-4), but rejects the remainder as being argumentative, conclusory, and misrepresentative: e.g., the primary issue of the case was the application of the doctrine of estoppel in suppression of the equivalency doctrine for reasons already stated.

STATEMENT

Respondent was declaratory judgment plaintiff and counterclaim defendant in a suit involving the infringement and validity of petitioner's U. S. Patent to Hillenbrand and Laugle, No. 2,664,615 (R. 302-314) relating to a casket interior unit made out of cardboard in simulation of, and as a substitute for, the upholstered interior previously applied to this purpose. Cardboard liners for coffin lids were not new, but had appeared in the prior art, e.g., Bowler Patent No. 2,181,504, (R. 315 *et seq.*). Petitioner asserted infringement by respondent, and respondent brought its suit for declaratory judgment. Petitioner answered and counterclaimed that respondent infringed. Issue was joined on the counterclaim respecting the infringement and validity questions.

The issues are the ordinary ones involving validity and infringement that attend all patent cases. No unusual, un-

settled, conflicting, or important public interest issues are presented for the consideration of this Court. The writ is a thinly veiled attempt by petitioner to further its private ends by asking this Court to review that which has been fully briefed and argued below, to reverse, and to hold respondent to account for infringement.

The equivalency doctrine of the *Graver* case is not applicable as asserted by the Petition, whereby the Opinion of the Court below is not in conflict therewith.

Firstly, the Court below turned its reversal upon file wrapper estoppel[*] in denying the equivalency upon which the District Court found infringement, whereby conflict with the *Graver* decision was not only absent, but the decision aligned with the settled law of this Court relative to file wrapper estoppel:

> *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 311 U.S 211, 218, 220-221, and
>
> *Exhibit Supply Co.* v. *Ace Patents Corp.*, 315 U.S. 126, 136-137,

and cases cited therein.

With respect to the limiting effect upon the doctrine of equivalents, imposed by that of file wrapper estoppel, attention is invited to the following cases that are a repre-

---

[*] "For reasons to be discussed, we hold that the scope of the claims of the two Hillenbrand patents is limited by their prosecution history and hence finding of fact 19 is clearly erroneous. Thus limited the patent claims cannot be expanded by the doctrine of equivalents so as to embrace those particulars excluded by the prosecutional history of the patent. *Lewis* v. *Arco Manufacturing Corp.*, 228 F.2d 919 (7th Cir. 1956). Of necessity, finding of fact 20, flowing from an erroneous application of the doctrine of equivalents, must also fail as being clearly erroneous." (Opinion, Pet. App. A, pp. 5a-6a).

sentative sampling from several of the appellate circuit courts, most of which were decided long after the *Graver* case decision was announced by this Court in 1950:

> *Doran Coffee Roasting* v. *Wyott Mfg.* (10 Cir. 1959) 267 F.2d 200, 203
>
> *Dixie Cup* v. *Paper Container Mfg.* (7 Cir. 1948) 169 F.2d 645, 648
>
> *Carter Products, Inc* v. *Colgate Palmolive Co.*, (D.C. Md. 1958) 164 F.Supp. 503, 518; affirmed 269 F.2d 299, 304 (4 Cir. 1959)
>
> *McGraw-Edison* v. *Central Transformer* (D.C. Ark. 1961) 196 F. Supp. 664, 671, affirmed 305 F.2d 70 (5 Cir. 1962).

Secondly, in *Graver*, the Court found Rule 52(a), F.R.C.P. controlling where equivalency had been found on extensive expert testimony directed to complicated scientific and chemical phenomena. Here, only simple cardboard forms, and the most elemental mechanical considerations apply. Secondly, it was clearly stated in *Graver* that the area of equivalence may vary under the circumstances (p. 608). There could scarcely be conceived two more antipodal areas than those of the complex chemical *Graver* case and the simplex mechanical case at bar, involving nothing more complicated than cardboard forms for use in decorating the interior of lids of burial caskets.

Extension of equivalency to the simple cardboard forms involved would not only go contrary to the patentees' posture throughout the record, but would contravene the public welfare doctrine as expressed by this Court in *Sontag Chain Stores Co.* v. *National Nut Co.*, 310 U.S. 281, 293. Not what might have been claimed but what was claimed is that upon which the public is entitled to rely.

Thirdly, it is further evident that the Court below was

motivated in its application of the doctrine of file wrapper estoppel in delimiting equivalency to preserve the validity of the patent in suit as a matter of law.

The Appellate Court's action in putting aside the District Court's findings against the admonition of Rule 52(a) F.R.C.P., has been approved by this Court on numerous occasions:

> "A finding is 'clearly erroneous' when although there is evidence to support it, the reviewing Court on the entire evidence is left with the definite and firm conviction that a mistake has been committed." *United States* v. *U. S. Gypsum Co.*, 333 U.S. 364, 395, cited with approval in *Commissioner of Internal Revenue* v. *Duberstein*, 363 U.S. 278, 291 (1960).

This fits the present situation. On no possible ground is this case worthy of the Court's consideration.

CONCLUSION

The writ should be denied.

Respectfully submitted,

PATRICK H. HUME
CLYDE F. WILLIAN
Attorneys for Respondent

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* Again, to classify as an equivalent a feature that is designed to permit flexibility in the accused insert and which lacks any of the attributes called for by the patented insert, save for final appearance which we have already said was not patented, would grant to the patentee a monopoly over casket lid inserts not anticipated by the Patent Office and would seriously call into question the validity of the patent in light of the file wrapper history already discussed (Opinion, Pet. App. A. p. 11a).